

REMARKS

Summary of Office Action

Claims 1-28 and 30-38 are pending in this application.

Claim 10 was objected to an informality.

Claims 1, 4, 6-8, 11, 19, 22, 25 and 33-38 were rejected under 35 U.S.C. § 102(e) as being unpatentable in view of Freeman U.S. Patent No. 6,068,183 (hereinafter "Freeman").

Claims 2, 3, 20, 21, 23 & 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Rowland U.S. Patent No. 5,801,970 (hereinafter "Rowland").

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Eisele U.S. Patent No. 6,089,459 (hereinafter "Eisele").

Claims 9, 10, 12-16, and 26-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Hornback WO 99/56463 (hereinafter "Hornback").

Claims 30-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Ray U.S. Patent No. 5,321,751 (hereinafter "Ray").

Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman.

Summary of Applicant's Amendments

Applicant has amended claim 10 to correct a typographical error.

Applicant has amended claims 1, 11-16, 18, 19-22, 24, 25, 27, 28, 30, 33, 36, and 38.

Applicant's Response to the Claim Objection

Claim 10 was objected to an informality. Applicant has amended claim 10 to correct the informality. Accordingly, applicant respectfully requests that the Examiner's objection of claim 10 be withdrawn.

Applicant's Response to the Rejection Under 35 U.S.C. § 102(e)
In view of Freeman

Claims 1, 4, 6-8, 11, 19, 22, 25 and 33-38 were rejected under 35 U.S.C. § 102(e) as being unpatentable in view of Freeman.

Claims 1, 4, and 6-8

Applicant's invention of amended claim 1 includes user-provided digital images.

The Examiner stated that:

"In fact, **the card issuer** by means of network computer (42) is the only one that has ability to add images into the card. It appears that the user does not have any ability to add additional images into the card nor do anything to modify the images by his/her own computer. At best, the user can only keep the already stored images of interest by setting the card into the protect mode."

(Office Action, page 3)

As stated by the Examiner, Freeman does not allow a user to add images into a card. Accordingly, Freeman does not show or suggest applicant's invention of amended claim 1 of user-provided digital images.

Furthermore, Freeman cannot be combined with any system that allows user loading of images into a device. Freeman teaches away from such a functionality and the addition of the functionality to the Freeman device would eviscerate the spirit of the non-user loading Freeman device.

Additionally, applicant's invention of amended claim 1 includes an electronic display where the display area of the electronic display is more than half the size of the area of the surface of the housing structure about the electronic display (e.g., See applicant's FIG. 1A). Similarly, applicant's invention of amended claim 1 includes an electronic display that is a touch-screen electronic display. Freeman does not show or suggest either feature.

In light of the foregoing, applicant respectfully submits that the Examiner's rejection of claim 1 under 35 U.S.C. § 102(e) , and any claims dependent therefrom, be withdrawn.

Claims 11

Applicant has amended claim 11 to include a computer that receives images as a result of a first user input and sends the images to the portable photo album for storage in the memory as a result of a second user input.

The Examiner stated that:

"In fact, **the card issuer** by means of network computer (42) is the only one that has ability to add images into the card. It appears that the user does not have any ability to add additional images into the card nor do anything to modify the images by his/her own computer. At best, the user can only keep the already stored images of interest by setting the card into the protect mode."

(Office Action, page 3)

As stated by the Examiner, Freeman does not allow a user to add images into a card. Accordingly, Freeman does not show or suggest applicant's invention of amended claim 11.

Furthermore, Freeman cannot be combined with any system that allows user loading of images into a device. Freeman teaches away from such a functionality and the

Express Mail: EV371749682US
addition of the functionality to the Freeman device would
eviscerate the spirit of the non-user loading Freeman device.

In light of the foregoing, applicant respectfully
submits that the Examiner's rejection of claim 11 under 35
U.S.C. § 102(e) , and any claims dependent therefrom, be
withdrawn.

Claim 19

Applicant's invention of amended claim 19 includes
user-provided digital images. As shown above in conjunction
with the arguments for the patentability of claims 1 and 11,
Freeman does not show or suggest such a feature and Freeman
cannot, by nature of the Freeman device, be combined with a
device that allows for user-provided digital images.

In light of the foregoing, applicant respectfully
requests that the Examiner's rejection of claim 19 be
withdrawn.

Claims 22 and 25

Applicant's invention of amended claim 22 includes
user-provided digital images. As shown above in conjunction
with the arguments for the patentability of claims 1 and 11,
Freeman does not show or suggest such a feature and Freeman

Express Mail: EV371749682US
cannot, by nature of the Freeman device, be combined with a device that allows for user-provided digital images.

Accordingly, none of the references, used either alone or in combination, show or suggest applicant's invention of claim 22. Accordingly, applicant respectfully requests that the Examiner's rejection of claim 22, and any claims dependent therefrom, be withdrawn.

Claims 33-35 and 36-38

Applicant's inventions of amended claims 33 and 36 include user-provided digital images. As shown above in conjunction with the arguments for the patentability of claims 1 and 11, Freeman does not show or suggest such a feature and Freeman cannot, by nature of the Freeman device, be combined with a device that allows for user-provided digital images.

Accordingly, none of the references, used either alone or in combination, show or suggest applicant's invention of claims 33 and 36. In light of the foregoing, applicant respectfully submits that applicant's invention of claim 33 and 36, and any claims dependent therefrom, are allowable.

Applicant's Response to the
Rejections Under 35 U.S.C. § 103(a)

Claims 2, 3, 20, 21, 23, and 24

Claims 2, 3, 20, 21, 23, and 24 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Rowland.

As shown above, claims 1, 19, and 22 are allowable. Accordingly, claims 2, 3, 20, 21, 23, and 24 are allowable because claims 2, 3, 20, 21, 23, and 24 depend from one of allowable claims 1, 19, and 23.

Claim 5

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Eisele.

As shown above, claim 1 is allowable. Accordingly, claim 5 is allowable because claim 5 depends from allowable claim 1.

Claims 8-10, 12, 25, and 28

Claims 8-10, 12, 25, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Hornback.

As shown above, claims 1, 11, and 22 are allowable. Accordingly, claims 8-10, 12, 25, and 28 are allowable because claims 1, 11, and 22 depend from one of allowable claims 1, 11, and 22.

Claims 30-32

Claims 30-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Ray.

Applicant's invention of amended claim 30 includes user-provided digital images. As shown above in conjunction with the arguments for the patentability of claims 1 and 11, Freeman does not show or suggest such a feature and Freeman cannot, by nature of the Freeman device, be combined with a device that allows for user-provided digital images.

In light of the foregoing, applicant respectfully requests that the rejection of independent claim 30, and any claims dependent therefrom, be withdrawn.

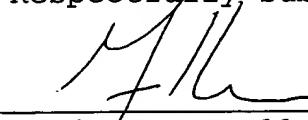
Claims 17 and 18

As shown above, claim 11 is patentable. Claims 17 and 18 depend from claim 11. Accordingly, applicant respectfully submits that claim 11 is patentable for depending from a patentable independent claim.

Conclusion

In light of the foregoing, applicant respectfully submits that this application, including each of claims 1-38, is in condition for allowance. Reconsideration and a favorable action are respectfully requested.

Respectfully submitted,



Jeffrey D. Mullen
Reg. No. 52,056
Agent for Applicant
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1104
Tel.: (212) 596-9000
Fax: (212) 596-9090